

REMARKS

This is in response to the non-final Official Action currently outstanding with regard to the above-identified application.

This application presently contains Claims 1-20. By the foregoing Amendment, Claims 1, 3-8 and 19 have been amended. No Claims have been added, canceled or withdrawn by the foregoing Amendment. Accordingly, upon the entry of the foregoing Amendment, Claims 1-20 as hereinabove amended will constitute the claims under active prosecution in this application.

In the currently outstanding Official Action, the Examiner has:

1. Failed to re-acknowledge Applicants' claim for foreign priority under 35 USC 119 (a) – (d) or (f), and reconfirmed the receipt by the United States Patent and Trademark Office of the required certified copies of the priority document therefor – **for the sake of good order in this prosecution, Applicant respectfully requests re-acknowledgement of its claim for foreign priority and reconfirmation of the receipt of the required copy of the priority document for this application in response to this communication;**
2. Indicated that the drawings originally filed as part of this application have been accepted;
3. Provided Applicants with a copy of a Form PTO-892 listing the newly cited reference;

4. Rejected Claims 1 and 19 under 35 USC 102(b) as being anticipated by the Bloomberg reference (US Patent 5, 181, 255);
5. Rejected Claims 2-13, 17-18 and 20 under 35 USC 103(a) as being unpatentable over the Bloomberg reference in view of the Ohki et al reference (US Patent No. 6,636,647); and
6. Rejected Claims 14-16 under 35 USC 103(a) as being unpatentable over the Bloomberg reference in view of the Ohki et al reference (US Patent No. 6,636,647) further in view of the Hart reference (US Patent No. 5,694,494).

Further comment on items 1-3 above is not deemed to be necessary in these Remarks.

With respect to item 4 above, Applicant respectfully calls the Examiner's attention to the Amendment to Claims 1 and 19 hereinabove (the amendments to Claims 3-8 being simply to conform those claims to the new wording of Claim 1) wherein it is clarified that (i) the reading portion reads *an image* of a form with data entered thereon, and (ii) that the storage portion *pre-stores mask data of the predetermined layout for superimposition upon the read out image*. Applicant respectfully submits that the new primary reference, Bloomberg (US Patent No. 5,181,255), does not disclose, teach or suggest the present invention as now herein claimed.

In particular, Applicant respectfully submits that it should be noted that in the Bloomberg reference no “storage portion in which mask data of the predetermined layout to be superimposed on a read out image is pre-stored” is disclosed, taught or suggested. Instead, the newly cited Bloomberg reference discloses a complex process whereby a mask is created and at best temporarily stored as part of the reading operation of the device therein disclosed.

Accordingly, it will be understood that in Bloomberg the input image is read into a storage portion (see, column 5, lines 40-56). Then, while the read data is maintained intact in storage 104, Bloomberg performs morphological processing on the read image so as to identify the regions thereof having characteristic features of handwritten annotations or machine printed text (i.e., the “form”). Then, the image processing proceeds to utilize the so identified regions of the read image to create a totally internally generated mask components for use in the elimination of the undesired portions of the originally read image so as to extract either the handwritten annotations or the machine printed text therefrom.

Consequently, Applicant respectfully submits that the Bloomberg reference does not contemplate the storage of mask data to be superimposed on the read out image data **except to the very limited extent that the mask components that result from the image processing operations exist within the Bloomberg device for ANDing with the original image retained in storage so as to extract either the handwritten annotations or the machine printed text from the stored original image.** In other words, it is clear from the Bloomberg disclosure that that reference does not contemplate that a mask or masks will be previous to operation of the reading apparatus be permanently maintained in storage for superimposition on a read image as appropriate for the deletion of undesired portions thereof.

Instead, the newly cited Bloomberg reference contemplates that the read image itself will be stored, and further that that read image will be processed in a manner such that *an intermediate image processing result* may be utilized in the creation of mask components *generated and existing only temporarily as part of the final image processing internally by the Bloomberg device* for deleting the undesired portion from the read image retained in the storage.

Accordingly, Applicant respectfully submits that in view of the foregoing facts it will be seen that the Bloomberg reference fails to disclose all of the elements of the present invention functioning together with one another in the manner now herein claimed as required to support the Examiner's outstanding rejection under 35 USC 102(b). A decision so holding and withdrawing the outstanding rejection under 35 USC 102(b) in response to this submission, therefore, is respectfully requested in response to this communication.

Further, Applicant respectfully submits that in light of the foregoing Amendment, which for the reasons just discussed fully and completely distinguishes the present invention from the newly cited Bloomberg reference, the present invention as herein claimed in the dependent claims of this application also would not have been obvious under the terms of 35 USC 103(a) to one of ordinary skill in the art at the time that the present invention was made for the same reasons as were set forth in response to the previous Official Action in this case.

More particularly, as previously noted, Applicant respectfully submits that the Examiner has failed to recognize that his own characterization of the Ohki reference is indicative of the difference between the present invention and that of the Ohki et al. reference. Thus, although the Ohki reference describes extracting image features using a mask image, it will be understood that the Ohki reference is characterized in that by superimposing a mask image on an area where two image data overlap each other, the features of the two images are extracted and thereafter are merged in a natural looking manner. In contrast, the present invention is characterized in that by superimposing a mask image on one image read from a predetermined form in which data has been entered by handwriting or the like, the handwritten part may be extracted.

Therefore, Applicant again respectfully submits that when the appropriate criteria for the establishment of a *prima facie* case of obviousness are applied to the Ohki reference, it will be readily understood that a person of ordinary skill in the art at the time that the present invention was made would not have been lead to the presently claimed invention from a consideration of the Ohki construction either alone or in combination with Bloomberg. Rather, it is only through a consideration of the Applicant's specification that the present invention becomes apparent to one skilled in the art even assuming knowledge of the Ohki reference, i.e., it is only via improper hindsight reasoning that one of ordinary skill in the art would reach the present invention with or without the teachings of the Ohki and/or Bloomberg references before him.

It will be recalled in the above regard that the criteria for the establishment of a *prima facie* case of unpatentability under 35 USC 103(a) are set forth in the MPEP as follows:

To establish a *prima facie* case of obviousness under Section 103, Title 35 United States Code (35 US §103), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2D 1438 (Fed. Cir. 1991). (See, Manual of Patent Examining Procedure §2142 (8th Edition), at page 2100-2121, *et seq.*)

Furthermore, it will be recognized that since Ohki aims at merging image data in a natural looking manner, it is considered to be impossible in the case of Ohki that the printing means as disclosed in present Claim 19 of this application would be used for printing out the data after superimposing the entered data extracted and the layout data stored previously.

Applicant also again respectfully submits that the Hart reference is inapposite to the present invention as now claimed.

In particular, the Hart reference is characterized in that both an image of a form (first image) and an image that information has been added to the form (second image) are read out. Subsequently in Hart, the first image is subtracted from the second image so as to identify the added part. However, unlike the mask processing of the present invention, the Hart subtraction operation cannot delete the entire form unless the concentrations of the first and second images are the same (note the detail in the Hart specification concerning the comparison levels of each pixel utilized in arriving at the image of the added part). Thus, when the mask processing of the present invention is utilized, the predetermined form parts are completely deleted, while in the Hart reference this is only the case when the first and second image concentrations are substantially the same.

Hence, Applicant respectfully submits that the present invention is not obvious within the terms of 35 USC 103(a) over the Ohki reference, the Hart reference, or any combination of the Ohki and Hart references with each other or with the Bloomberg reference.

In view of the foregoing Response to the currently outstanding Official Action, Applicants respectfully submit that all of the claims now present in this application are in condition for allowance. A decision so holding and allowing Claims 1-20 as hereinabove amended in response to this communication is respectfully requested.

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Finally, Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

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